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23364 7590 03/04/2010 BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314-1176				
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* PING LIONG TJOA
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11 Appeal 2009-010006
12 Application 09/319,243
13 Technology Center 3600
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16 Decided: March 4, 2010
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20 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
21 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

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23 FETTING, *Administrative Patent Judge*.
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26 DECISION ON APPEAL

STATEMENT OF THE CASE

Ping Liong Tjoa (Appellant) seeks review under 35 U.S.C. § 134 (2002) of a final rejection of claims 12 and 14-23, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION¹

We AFFIRM.

THE INVENTION

The Appellant invented a training apparatus (Spec. 1:First ¶).

An understanding of the invention can be derived from a reading of exemplary claim 12, which is reproduced below [bracketed matter and some paragraphing added].

12. A training apparatus for massaging the palms and for promoting body bearing and motion, comprising:
[1] an intermediate element formed as a rod; and
[2] identical end elements,

[2a] each situated at a respective end of said intermediate element,

[2b] wherein each end element has

a spherical region,

the diameter of which is adapted to the palm of the hand of a training person with a nondiscontinuous spherical surface remote from said intermediate element,

¹ Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed August 28, 2006) and Reply Brief ("Reply Br.," filed March 21, 2007), and the Examiner's Answer ("Ans.," mailed January 30, 2007).

1 a turning region and
2 a conversely concave region on its side toward said
3 intermediate element,
4 said turning region making a steady
5 transition into said conversely concave
6 region,
7 [2c] wherein said conversely concave region making a
8 steady transition to said intermediate element, and
9 [2d] wherein the total length of the training apparatus
10 between and including said spherical regions is
11 approximately in the range of the length of the shoulder
12 span of the person using it.

13 14 THE REJECTIONS

15 The Examiner relies upon the following prior art:
16 Bosko US 3,334,899 Aug. 8, 1967
17 Jackson US 4,002,163 Jan. 11, 1977
18 Coallier US 5,580,336 Dec. 3, 1996
19 Claims 12, 14-16, and 22-23 stand rejected under 35 U.S.C. § 102(b)
20 as anticipated by Bosko.
21 Claim 17 stands rejected under 35 U.S.C. § 103(a) as unpatentable
22 over Bosko and Coallier.
23 Claims 18-21 stand rejected under 35 U.S.C. § 103(a) as unpatentable
24 over Bosko and Jackson.

25 26 ARGUMENTS

27 The Appellant argues these claims as a group. Accordingly, we select
28 claim 12 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2009).
29 The Appellant contends that a dumbbell is too short to read on the
30 claim and a barbell would be too massive and heavy. Appeal Br. 3. As to

the obviousness rejections, the Appellant does not argue that the art fails to read on the claims, but instead argues that the declarations offered for secondary evidence have not been considered.

ISSUES

The issue of whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 12, 14-16, and 22-23 under 35 U.S.C. § 102(b) as anticipated by Bosko turns on whether Bosko describes a device as recited in the claims.

The issue of whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claim 17 under 35 U.S.C. § 103(a) as unpatentable over Bosko and Coallier and claims 18-21 under 35 U.S.C. § 103(a) as unpatentable over Bosko and Jackson turns on whether the evidence of secondary considerations overcomes a prima facie case for obviousness.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Claim Construction

01. The disclosure contains no lexicographic definition of “adapted.”

02. The ordinary and customary meaning of “adapt” is to make suitable to or fit for a specific use or situation. “Adapted” is the intransitive form of adapt.²

Facts Related to the Prior Art

Bosko

03. Bosko is directed to a simply constructed dumbbell type device that may be quickly converted into a barbell. Bosko 1:14-17.

04. Bosko portrays in its Figure 7 a bar with a spherical element on each end having a turning region and a conversely concave region on its side toward said intermediate element. Each turning region makes a steady transition into the conversely concave region. The conversely concave region makes a steady transition to the bar.

05. Bosko describes how the weight and size of its device can be altered at the user’s discretion. Bosko 3:40-45.

Coallier

06. Coallier is directed to a small exercising device (Coallier 1:4) that is formed by a bar with a spherical end element on each end (Coallier Fig. 1).

Jackson

07. Jackson is directed to an exerciser that also massages certain body parts. Jackson 1:6-10.

Facts Related To Secondary Considerations

08. The Appellant filed two declarations of commercial success as evidence of secondary considerations of non-obviousness for our consideration.

² *American Heritage Dictionary of the English Language* (4th ed. 2000).

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily). *See also Tex. Digital*, 308 F.3d 1200, 1204-05 (Fed. Cir. 2002).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

1 *Anticipation*

2 "A claim is anticipated only if each and every element as set forth in
3 the claim is found, either expressly or inherently described, in a single prior
4 art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d
5 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or
6 compositions, either generically or as alternatives, the claim is deemed
7 anticipated if any of the structures or compositions within the scope of the
8 claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.
9 Cir. 2001). "The identical invention must be shown in as complete detail as
10 is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d
11 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by
12 the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology
13 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

14 *Obviousness*

15 A claimed invention is unpatentable if the differences between it and
16 the prior art are "such that the subject matter as a whole would have been
17 obvious at the time the invention was made to a person having ordinary skill
18 in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 550
19 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

20 In *Graham*, the Court held that the obviousness analysis is bottomed
21 on several basic factual inquiries: "[1)] the scope and content of the prior art
22 are to be determined; [(2)] differences between the prior art and the claims at
23 issue are to be ascertained; and [(3)] the level of ordinary skill in the
24 pertinent art resolved." 383 U.S. at 17. *See also KSR*, 550 U.S. at 406.
25 "The combination of familiar elements according to known methods is likely
26 to be obvious when it does no more than yield predictable results." *Id.* at
27 416.

ANALYSIS

Claims 12, 14-16, and 22-23 rejected under 35 U.S.C. § 102(b) as anticipated by Bosko.

The Examiner found that Bosko described a rod with two spherical ends where the rod was generally of the length of a shoulder span. Ans. 3. The Appellant argued that Bosko's barbell was too massive and heavy. Appeal Br. 3. The Examiner responded that Bosko describes how the parts may be of any practical size. Ans. 5.

We agree with the Examiner that Bosk portrays in its Figure 7 a bar with a spherical element on each end. FF 04. Accordingly, Bosko's barbell structurally meets the limitations of claim 12. Apparently the only dispute is to the term "adapted" in limitation [2b] requiring the diameter to be adapted to the palm of the hand.

First, as to the argument regarding weight, the claim requires the diameter be adapted, not the weight. As to whether Bosko is too massive to be adapted to the palm, we must first construe the term "adapted."

The disclosure contains no lexicographic definition of "adapted." FF 01. The ordinary and customary meaning of "adapt" is to make suitable to or fit for a specific use or situation. "Adapted" is the intransitive form of adapt. FF 02. Thus, the limitation requires that the end element have a diameter such that it is suitable to or fit for the palm of the hand. There are no other criteria in the claim regarding such suitability. So far as we can see, the only general requirement for such suitability is that the palm be able to contact the surface. So, we construe the term adapted to the palm of the hand to mean structured so the palm can be in contact with.

Clearly, the spherical elements in Bosko's Figure 7 allow such contact. As to the Appellant's argument that a barbell is too massive, there is no mention in the claim of mass being one of the criteria. Further, as the Examiner found, the weight and size of Bosko's spherical elements can be at the user's discretion. FF 05.

Claim 17 rejected under 35 U.S.C. § 103(a) as unpatentable over Bosko and Coallier.

Claims 18-21 rejected under 35 U.S.C. § 103(a) as unpatentable over Bosko and Jackson.

The Appellant submitted two declarations as evidence of commercial success. FF 08. The Appellant argues that the Examiner did not give these declarations adequate consideration. Appeal Br. 5. The Examiner found that the declarations did not provide evidence of non-obviousness over the applied prior art. Ans. 7. We agree that the declarations provide no comparison with the structures in the prior art and therefore present no evidence of how the claim is not obvious over the prior art. The declarations state that the claimed structure provides utility, but do not provide any evidence that the structures in the prior art would not have been equally useful, particularly to breadth of possible embodiments that would be within the claim scope.

CONCLUSIONS OF LAW

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claims 12, 14-16, and 22-23 under 35 U.S.C. § 102(b) as anticipated by Bosko.

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